

Application No.: 10/610,483

Docket No.: 60680-1711

REMARKS

Applicants have carefully reviewed the Office Action mailed May 26, 2005, and thank Examiner Walberg for her detailed review of the pending claims. The requested changes have been made to the Abstract to conform to MPEP §608.01(b). Claim 1 has been amended. Claim 7 has been canceled and its key limitations have been included in claim 1. Accordingly, claims 1 – 6 and 8 – 13 remain pending in this application. Applicants respectfully request reconsideration of the present application in view of the following remarks. No new matter has been added.

I. Claim Rejections Under 35 U.S.C. §102(b) based on Verkaart

Claims 1, 2, 4 – 6, 9, 11, and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by Verkaart (U.S. Patent No. 5,097,898). Applicants respectfully traverse the rejection.

To anticipate a claim, the reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

The Applicants claim “a fluid splitter body” as disclosed in the specification. Verkaart does not teach or suggest “a fluid splitter body.” The Examiner asserts that the first cylindrical portion 42 of Verkaart is a fluid splitter body. See *Office Action* page 2, item 4. Applicants disagree with this improper characterization of the reference.

First, Applicants have amended claims 1 and 11 to further clarify that the fluid splitter body “allows fluid to travel in both directions.” See *specification* page 2, paragraph [0006]. In contrast, FIG. 3 of Verkaart shows that the fluid flows from inner tube 16 in only one direction. In fact, Verkaart states that a supply of infusate is at one end and a patient is at the other end of the inner tube. See *col. 1, lines 61 – 64*.

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Applicants disclose the “fluid splitter body” such that: “The inner conduit 12 extends longitudinally to supply fluid, such as water, from the pump 116 to a heat exchanger 134, such as a heater core, or the like.” *See page 4, paragraph [0017]*. “The passageway 70 enables the relatively cooler return fluid flowing through the outer conduit 18 from the heater core 134 to be in fluid communication with the pump 116.” *See page 6, paragraph [0023]*. This “allows fluid to travel in both directions.” *See page 2, paragraph [0006]*.

In stark contrast, the first cylindrical portion 42 of Verkaart is simply part of a second end cap 40 and not “a fluid splitter body” as claimed. FIG. 3 of Verkaart shows that the fluid flows from inner tube 16 in only *one* direction. In fact, Verkaart states that a supply of infusate is at one end and a patient is at the other end of the inner tube. *See col. 1, lines 61 – 64*. The first cylindrical portion 42 is adapted to engage the outer surface of outer tube 14. *See col. 3, lines 35 – 37*. The first cylindrical portion 42 has an inner conduit 44 incorporated into the bottom wall that tapers from a larger diameter to a smaller diameter capable of being received in inner tube 16. *See col. 3, lines 37 – 40*. A second end is a female luer 45 that is received in a second cylindrical portion 43 such that the female luer 45 is in fluid communication with conduit 44. *See col. 3, lines 41 – 43*. Therefore, Verkaart does not teach, suggest, or contemplate “a fluid splitter body” as claimed because the first cylindrical portion 42 does not and could direct fluid to travel in two directions.

Second, Verkaart does not teach a “fluid splitter body” because the first cylindrical portion 42 of Verkaart does nothing to teach “improving the thermal efficiency of the fluid system.” *See specification page 2, paragraph [0007]*. In fact, “[t]he space between the inner and outer tubes is designed to carry a warming fluid, and the inner tube is designed to carry an infusate to be warmed.” *See col. 2, lines 62 – 64*. As shown in FIG. 8 of Verkaart, “[o]pening 62 is connected to an outlet of a source of warming fluid, while opening 64 is connected to a return line for the warming fluid.” *See col. 4, lines 10 – 12*. Therefore, Verkaart does not teach, suggest, or contemplate “a fluid splitter body” as claimed.

In addition, Applicants have amended the claim 1 to include the limitations of claim 7. Specifically, the first fluid is transferred from a pump to a heater core of a heater system. The Examiner admits that the prior art does not teach the conduit assembly in combination with a pump, a heater core of a heater system, and a heat reservoir. *See Office Action page 4, item 8*.

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For at least these reasons, amended independent claim 1 and independent claim 11 are patentable over the cited reference. Withdrawal of the rejection is respectfully requested.

II. Claim Rejections Under 35 U.S.C. §102(b) based on Thayer

Claims 1, 2, 4, 5, and 10 were rejected under 35 U.S.C. §102(b) as being anticipated by Thayer (U.S. Patent No. 2,085,677). Applicants respectfully traverse the rejection.

As stated above, to anticipate a claim, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicants have amended claim 1 to include the key limitations of claim 7. Specifically, the first fluid is transferred from a pump to a heater core of a heater system. The Examiner admits that the prior art does not teach the conduit assembly in combination with a pump, a heater core of a heater system, and a heat reservoir. *See Office Action page 4, item 8.*

As a result of the amendment, every element as set forth in independent claim 1 is not found. Therefore, independent claim 1 is patentable over the prior art of record. Dependent claims 2 – 6 and 8 – 10 are patentable by virtue of their dependency on patentable claim 1. However, the dependent claims also contain additional limitations that are independently patentable. Withdrawal of the rejection is respectfully requested.

III. Claim Rejections Under 35 U.S.C. 103(a) based on Verkaart in view of Galvin

Claims 3 and 13 were rejected under 35 U.S.C. 103(a) as being unpatentable over Verkaart (U.S. Patent No. 5,097,898 in view of Galvin et al. (U.S. Patent No. 4,231,228). Applicants respectfully traverse the rejection.

The remarks presented above with respect to the §102 rejection of claims 1 and 11 are equally applicable here. Additionally, the inadequacy of Verkaart to teach every element of

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independent claims 1 and 11 by not teaching "a fluid splitter body" is not cured by the teachings of Galvin.

Independently of the complete lack of teaching of a critical claim element in each of the independent claims, Applicants respectfully traverses the 103(a) rejections to dependent claims 3 and 13 because there is no suggestion, motivation, or objective reason to combine the cited references. "If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue." *In re Rouffet*, 47 USPQ2d 1453 at 1457 (Fed. Cir. 1998). "Rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be 'an illogical and inappropriate process by which to determine patentability'." *Id.* quoting *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

In re Oetiker further provides that "[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." "The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998).

As established by Federal Circuit precedent, to establish a *prima facie* case of obviousness, the examiner must provide some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. *See, e.g., Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references"); *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"; *ACS Hosp. Sys. v. Montefiore*

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Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) ("Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination"); *accord.* MPEP 2143.

It is established law that one "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Ecolochem, Inc. v. Southern Cal. Edison Co.*, 227 F.3d 1361, 1371, 56 USPQ2d 1065 (Fed. Cir. 2000) (citing *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1780, 1783 (Fed. Cir. 1988)). Indeed, "[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Moreover, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Applicants respectfully submit that it is inappropriate to combine Verkaart and Galvin to reject the claims since there is no suggestion or motivation to combine. The Examiner asserts that "it would have been obvious in view of Galvin to use a saddle joint for connection of the conduits of Verkaart, the motivation being to provide a stronger joint." *See Office Action page 4, item 7.* The alleged motivation for combining the claims comes from a statement by the Examiner and not from either one of the references. There is nothing in either Verkaart or Galvin that would lead one of ordinary skill in the art to take the end cap (26, 40) in Verkaart and combine it with the saddle joint of Galvin.

To the extent the Examiner intends to take Official Notice of known saddle joints in a fluid splitter body as claimed, Applicants seasonably request that the Examiner provide documentary evidence to support the taking of Official Notice as is required by 37 CFR § 1.104(d)(2) and MPEP § 2144.03.

For at least these reasons, dependent claim 3 and 13 are independently patentable over the prior art of record. Withdrawal of the rejection is respectfully requested.

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IV. Claim Rejections Under 35 U.S.C. 103(a) based on Verkaart or Thayer

Claim 8 was rejected under 35 U.S.C. 103(a) as being unpatentable over Verkaart (U.S. Patent No. 5,097,898) or Thayer (U.S. Patent No. 2,085,677) in view of the admitted prior art. The key limitations of dependent claim 7 have been included in independent claim 1. Applicants respectfully traverse the rejection.

The remarks presented above with respect to the §102 rejection of claim 1 are equally applicable here. Additionally, the inadequacy of Verkaart or Thayer to teach every element of independent claim 1 by not teaching "a fluid splitter body" is not cured by the teachings of the prior art disclosed in the Background of the specification. Furthermore, the Examiner asserts incorrectly that Verkaart or Thayer may be combined with the prior art disclosed in the specification as further discussed below.

The Applicants claim "a fluid splitter body" as disclosed in the specification. Neither Verkaart nor Thayer teach or suggest "a fluid splitter body." The Examiner asserts that the first cylindrical portion 42 of Verkaart is a fluid splitter body. *See Office Action page 2, item 4.* Applicants disagree with this improper characterization of the reference for the reasons stated above.

MPEP Section 2143 sets forth the basic requirements for the Patent and Trademark Office to establish *prima facie* obviousness as follows: "To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As stated in *Akzo N.V. v. United States Int'l Trade Comm'n*, 1 USPQ2d 1241 (Fed. Cir. 1986), prior art references must be read as a whole.

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"The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 47 USPQ2d, 1453 at 1458 (Fed. Cir. 1998)

The Examiner further admits that the prior art does not teach the conduit assembly in combination with a pump, a heater core of a heater system, and a heat reservoir. *See Office Action page 4, item 8*. Therefore, the Examiner has improperly combined the prior art on pages 1 and 2 of the specification with the devices of Verkaart or Thayer. To satisfy the FIRST requirement for providing a motivation for this combination, the examiner states that "the motivation being to make the heating system more efficient." *See Office Action page 4, item 8*. However, one skilled in the art would recognize that the devices of Verkaart or Thayer would not benefit the "thermal efficiency of the fluid system" having a pump and a heater core as claimed.

If the Examiner must select the motivation to combine prior art references from the applicant's specification (since the prior art references do not supply the motivation), then the requirement of *In re Rouffet* must be met. Specifically, the Examiner must "show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references" in order to establish a *prima facie* case of obviousness. *In re Rouffet* at 1458. However, there is no motivation found in the cited references and if it were proper to look to the Background of the specification for motivation, not even Applicants' Background suggests a motivation to combine the cited references. Therefore, the Examiner has failed to overcome the FIRST element of providing a *prima facie* showing of obviousness as stated above.

The Examiner has failed to explain why one of skill in the art would have combined the device of Verkaart or Thayer to solve the problem confronting the inventors. Specifically, Verkaart makes no mention of a device that functions as a fluid splitter or transferring a fluid between a pump and a heater core of a heater system as claimed. Additionally, Thayer makes no mention of transferring a fluid between a pump and a heater core of a heater system as claimed. Accordingly, the Examiner has failed to meet the burden of *In re Rouffet* and establish a *prima facie* case of obviousness since no reasons for the combination have been provided.

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Again, *In re Oetiker* provides that “[t]here must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination.” “The examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. *In re Rouffet*, 47 USPQ2d 1453, at 1458 (Fed. Cir. 1998).

To the extent the Examiner intends to take Official Notice of a know device that functions as a fluid splitter body and transferring a fluid between a pump and a heater core of a heater system as claimed, Applicants seasonably request that the Examiner provide documentary evidence to support the taking of Official Notice as is required by 37 CFR § 1.104(d)(2) and MPEP § 2144.03.

Nothing in the prior art discloses a *reason, suggestion, or motivation* why Verkaart or Thayer should be combined where a fluid is transferred from a pump to a heater core of the heating system. Therefore, independent claim 1 as amended and dependent claim 8 should be found patentable over the prior art of record. Withdrawal of the rejection is respectfully requested.

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V. Conclusion

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 60680-1711 from which the undersigned is authorized to draw.

Dated: 8/23/05

Respectfully submitted,

By 

Michael B. Stewart

Registration No.: 36,018

RADER, FISHMAN & GRAUER PLLC

39533 Woodward Avenue

Suite 140

Bloomfield Hills, Michigan 48304

(248) 594-0633

Attorney for Applicants

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